

II. CLAIMS 1-6 ARE PATENTABLE UNDER 35 USC § 102(B) OVER HEALEY.

The Board should reverse the Examiner's improper final rejection of Claims 1-6 under 35 USC § 102(b) based on Healey, as Healey does not disclose all the claimed elements.

A. Healy does not Disclose Audio Circuitry as Called for in Claim 1.

In the Office Actions and in the Examiner's answer, the Examiner admitted that no audio circuitry was shown in Healey. Instead, the Examiner noted that the audio circuitry is inherent to the sonar. However, to establish inherence, "the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

The Examiner argues that Healey discloses a "sonar typed depth indicating instrument or the like" and that, since Webster's defines instrument as a device to "product/perform [sic] a music," the Healy "instrument" must have audio circuitry to produce such sound. Again, the Examiner has failed to provide a basis in fact or technical reasoning to support the determination that audio circuitry "necessarily flows" from the teachings of Healey.

Assuming for the sake of argument that Healey discloses a music producing "instrument," as proposed by the Examiner, it does not necessarily follow that such instrument requires an audio card. Applicant/Appellant submits that many (if not most) musical instruments generate sound without audio circuitry, either by the vibration of strings, reeds, or a portion of the

instrument, such as a hand drum, etc. Therefore, it does not “necessarily” follow that the Healy “instrument” requires an audio card or circuitry to generate sound, as most musical instruments do not require them either.

Because of this, Healey does not inherently have the claimed audio circuitry and thus cannot anticipate Claims 1-6. Applicant/Appellant thus urges the Board to reverse the Examiner’s improper final rejection of Claims 1-6 under 35 USC § 102(b) based on Healey.

B. Healy does not Show a Protective Bar Flexibly Connected to the Housing.

In the Appeal Brief, Applicant/Appellant argued that the base 14 is not a “protective bar” as argued by the Examiner, and base 14 is not flexibly connected to the housing as called for in Claim 1.

This is because, knob 34 is tightened to fix the angular position of housing 10 relative to base 14, compressing washers 30, 38. Because of this compression, base 14 is not flexibly connected to the housing as the washers 30, 38 are so compressed that they cannot absorb any shock force, as evidenced by the declaration of a person skilled in the art.

Did the Examiner provide any evidence to counter such argument or declaration? No. The Examiner just repeated his previous argument. Such failure to provide any evidence that the bar is flexibly connected to the housing should be interpreted as what it is: the Examiner does not have any evidence to support his position.

UTILITY PATENT

B&D No. P-US-TN1444

Because of this, Healey does not inherently have the claimed protective bar and thus cannot anticipate Claims 1-6. Applicant/Appellant thus urges the Board to reverse the Examiner's improper final rejection of Claims 1-6 under 35 USC § 102(b) based on Healey.

Respectfully submitted,

A handwritten signature in black ink, appearing to be 'Adan Ayala', written over a horizontal line.

Adan Ayala
PTO Reg. No. 38,373
Attorney for Applicants/Appellant